

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 5/7/99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Platinum Technology, Inc.

Serial No. 74/523,161

Martin R. Greenstein of Techmark for Platinum Technology,
Inc.

Rita M. Odin, Trademark Examining Attorney, Law Office 109
(Deborah S. Cohn, Managing Attorney)

Before Hanak, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Platinum Technology, Inc. (applicant) seeks to
register in typed drawing form PLATINUM BIND ANALYZER for
"computer software for use in the field of databases,
database management and administration, database design and
implementation, database query and reporting, programming
and application development, and instructional manuals
distributed therewith." The application was filed on May

14, 1994 with a claimed first use date of April 15, 1993.

At the request of the Examining Attorney, applicant disclaimed the exclusive right to use the word BIND.

It is the position of the Examining Attorney that the word ANALYZER is descriptive of applicant's goods, and hence must also be disclaimed. Applicant takes the position that the word ANALYZER is not descriptive of its goods, and hence need not be disclaimed.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

First, as has been stated repeatedly, "a term is merely descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]." In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) (emphasis added); Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976). Moreover, the immediate idea must be conveyed with a "degree of particularity." In re TMS Corp. of the Americas, 200 USPQ 57, 59 (TTAB 1978); In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd 90-1495 (Fed. Cir. February 13, 1991).

The Examining Attorney has never taken issue with applicant's contention that "virtually every software product must do some kind of interim analysis or review of data before it can operate properly. Such a broad term [analyzer] identifying a necessary interim step of all software can hardly be considered primarily merely descriptive of applicant's highly specific software." (Applicant's brief page 3). See Examining Attorney's brief page 4. Moreover, the Examining Attorney has made of record no dictionary listings or articles wherein the composite term "bind analyzer" appears.

Accordingly, we find that the word ANALYZER is not descriptive of applicant's software because it simply fails to convey any information concerning the qualities or characteristics of applicant's software with the required "degree of particularity."

We note that applicant has obtained registrations on the Principal Register of the following marks for closely related types of computer software without any disclaimer of ANALYZER: PLATINUM RECOVERY ANALYZER; PLATINUM LOG ANALYZER; PLATINUM DATABASE ANALYZER; and PLATINUM PLAN ANALYZER. This Board has previously held that prior "registrations, of course, may be used to indicate that a commonly registered element has a suggestive meaning for

particular goods or services." Spoons Restaurants Inc. v. Morrison Inc., 23 USPQ2d 1735, 1740 (TTAB 1991). We believe that applicant's four existing registrations of PLATINUM_ANALYZER for closely related computer software, all of which registrations issued fairly recently in 1994 or 1995, are further evidence that the term ANALYZER is simply not descriptive of computer software in that, as the Examining Attorney concedes, all computer software must do some analysis, and hence, the word ANALYZER simply does not convey any information with the required degree of particularity.

Of course, to the extent that there are doubts on the issue of mere descriptiveness, said doubts are resolved in favor of the applicant. In re Gourmet Bakers Inc., 173 USPQ 565 (TTAB 1972).

Decision: The refusal to register is reversed.

E. W. Hanak

P. T. Hairston

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial and
Appeal Board